

It will be noted that the aforesaid U.S. Patent No. 5,843,560 is assigned on its face jointly to RICOH COMPANY, LTD. and TOHOKU RICOH CO., LTD. U.S. Patent Application No. 09/204,603, now U.S. Patent No. 6,372,332 (of which the above-identified Application No. 10/060,458 is a division), together with "all divisional . . . applications for U.S. Letters Patent," is assigned jointly to RICOH COMPANY, LTD. and TOHOKU RICOH CO., LTD. by virtue of an assignment executed February 1, 1999, and recorded in the United States Patent and Trademark Office on July 2, 1999, at Reel No. 010099, Frame 0284.

#### **R E M A R K S**

Claims 11 - 21 are in the application. Of these, claim 11 is independent and claims 12 - 21 are dependent on claim 11. All claims are directed to a method of producing a thermosensitive stencil paper. Claims 13, 15 and 21 are withdrawn from consideration pursuant to an election of species. Claims 11, 14, 16, 17, 19 and 20 have been finally rejected under 35 U.S.C. §102(e) as anticipated by Ohta et al. '560. Claims 12 and 18 have been finally rejected under 35 U.S.C. §103(a) as unpatentable over Ohta et al. '560. No claim has been allowed.

#### ***Distinction over the Reference***

With reference to the rejection of claim 11 as anticipated by Ohta et al. '560, it may initially be noted that the claim recites a step of "coating on said thermoplastic resin film a porous resin layer formation coating liquid comprising a water-in-oil emulsion of a resin . . . ." This step requires that the coating liquid, as coated on the fiber, comprise a water-in-oil emulsion.

Applicants respectfully submit that this step is neither expressly taught by nor inherent in the disclosure of Ohta et al. '560.

The Examiner asserts that "an emulsion is defined as a liquid dispersed in an immiscible liquid, which Ohta teaches by mixing water and oils, which are immiscible. This alone would create an emulsion." However, Ohta et al. '560 is not seen to teach any "liquid dispersed in an immiscible liquid" at least in a porous resin layer formation coating liquid. To be sure, the patent describes (col. 2, lines 15-19) a coating liquid "including a first solvent capable of dissolving said resin and a second solvent substantially incapable of dissolving said resin and having an evaporation rate lower than that of said first solvent." But two solvents which are respectively "good" and "bad" solvents for a resin, and differ in evaporation rate, are not necessarily immiscible with each other.

That solvents (of differing evaporation rate) which are respectively "good" and "poor" solvents for a resin may nevertheless be miscible with each other will be readily apparent from Table 1 at cols. 5 and 6 of Ohta et al. '560. Ethanol is therein listed as a "good" solvent for polyvinyl butyral ("VB\*12") and water is listed as a "poor" solvent for the same resin, but it is very well known that ethanol and water are miscible. Thus, in Example 1 of Ohta et al. '560, there is and can be no emulsion.

Again, THF (specifically mentioned by the Examiner) is listed in the *Merck Index* (13<sup>th</sup> ed., 2001, at pp. 9285-86) as "Miscible with water, alcohols . . . ." Hence, THF in a water solvent would not provide the water-in-oil emulsion required by claim 11. In the only specific example of use of THF in Ohta et al. '560, Example 9, THF is used together with ethanol, an alcohol, with which (according to the *Merck Index*) THF is miscible.

Citing the statement at col. 4, lines 16-18, in Ohta et al. '560, that the porous resin layer can contain additives such as a

stick-preventing agent and a surfactant, the Examiner observes that Ohta et al. '560 teaches that silicone can be used as a stick-preventing agent. As to this, applicants note that Ohta et al. '560 describes use of a silicone agent as a stick-preventing agent only in the stick-preventing layer (col. 4, lines 48-50), and does not teach its suitability for use as a stick-preventing agent in the porous resin layer (see col. 4, lines 16-17).

Moreover, the amount of stick-preventing agent that might be included in the porous resin layer formation coating liquid is not specified or illustrated in the patent (no silicone is included in the porous resin layer formation coating liquid of any example of the patented invention, although "a liquid," unspecified, "containing a silicone resin" is used in some of the comparative examples and also to form the stick preventing layer of certain examples). If used in the porous resin layer formation coating liquid of the patent, it might well result in an oil-in-water emulsion rather than in the water-in-oil emulsion to which present claim 11 is limited.

The particular importance of a **water-in-oil** emulsion, for the attainment of the advantages of the present invention, is explained in the second paragraph on p. 11 of applicants' specification. There is assuredly no intimation in Ohta et al. '560 that such advantages could thereby be achieved, hence no motivation to modify or select ingredients of the porous resin layer formation coating liquid so as to provide a water-in-oil emulsion.

Use of a surfactant in the porous resin layer formation coating liquid of Ohta et al. '560 would not result in an emulsion unless immiscible liquids were present. An emulsifier cannot produce an emulsion unless there are immiscible liquids to emulsify.

In summary, Ohta et al. '560 does not disclose or suggest any composition, for use or application as a porous resin layer formation coating liquid, that even inherently comprises, includes or contains a dispersion of liquids immiscible in each other so as to provide a water-in-oil emulsion. Consequently, the patent does not anticipate or make obvious any step of coating, on a resin film, a porous resin layer formation coating liquid comprising a water-in-oil emulsion, as recited in claim 11. It follows that this recital distinguishes claim 11, and claims 12 - 21 dependent thereon, clearly and patentably over Ohta et al. '560.

### ***Common Ownership***

Since the present application was filed on January 30, 2002, and since Ohta et al. '560 is applied only as a §102(e)/§103(a) reference against claims 12 and 18, the above Statement of Common Ownership overcomes the rejection of claims 12 and 18 as unpatentable over Ohta et al. '560. 35 U.S.C. §103(c); M.P.E.P. §706.02(1)(2).

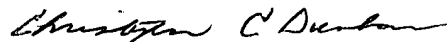
The rejection of claims 11, 14, 16, 17, 19 and 20 under 35 U.S.C. §102(e) as anticipated by Ohta et al. '560 is of course not overcome by the Statement of Common Ownership. It is submitted, however, that the discussion above clearly establishes that Ohta et al. '560 does not anticipate claim 11 (or any of the claims dependent thereon) because it does not expressly or inherently teach any water-in-oil emulsion, to which claim 11 is limited. Therefore, if claim 11 and any of its dependent claims were deemed to be still subject to rejection on Ohta et al. '560 at all, the rejection could only be an obviousness rejection under §103(a), i.e. Ohta et al. '560 could be applied only as a §102(e)/§103(a) reference, and such a rejection would likewise be overcome by the Statement of Common Ownership.

### ***Withdrawn Claims***

In view of the allowability of generic independent claim 11, examination of withdrawn species claims 13, 15 and 21 is respectfully solicited.

For the foregoing reasons, it is believed that this application is now in condition for allowance. Favorable action thereon is accordingly courteously requested.

Respectfully,



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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



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Date JULY 2, 2004